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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,448	11/21/2001	Adrian Velthuis	08011.3012-00	1416
22852	7590	06/21/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/989,448

Applicant(s)

VELTHUIS ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 4/6/06.

#### ***Response to Amendment***

2. The amendment filed 4/6/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- Claim 4 previously included a step of inputting information into a computer and the recent amendment adds another step of inputting information into another computer. A review of applicant's specification failed to reveal support for a user inputting information twice, into different computers. The example of a user inputting his cell phone number into a first computer responsive a banner ad on the first computer, triggering a coupon delivered to his cell phone (second computer) does not appear to be consistent with the new claim scope. It is unclear where support for a user entering information twice – on different computers is found. Nor is it clear where there is support for a user receiving an advertisement inputting information identifying a second computer whereby that advertisement is subsequently delivered to the second computer.
- Claim 5 appears to claim that the identified cell phone is then forwarded a web page which is not supported by the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). No support can be found for the subject matter of claims 4 and 5 (as above). Correction is required.

### ***Claim Objections***

4. Claim 11 is objected to because of the following informalities:

- Claim 11 apparently depends from the wrong claim – perhaps it should depend from claim 9?.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how a user can print a coupon that has been delivered to a cell phone. The specification appears to support delivery of a coupon via ***either*** printing the coupon ***or*** requesting the coupon be delivered to a second computer device as identified by inputted information, not both [FIG 4 – step 43].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 3-9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view of Sim (KR2000030358A).** Sim (KR2000030358A) is a document that was published June 5, 2000. The WO 01/63507 A1 document has been included merely as an English-language equivalent of Sim (KR2000030358A) and will be used to reference portions of Sim's disclosure which support the examiner's conclusions.

Regarding claims 1, 7-9, Mankoff et al teaches the concept of a user browsing webpages on the Internet and clicking a banner advertisement to request an electronic coupon be delivered (from a coupon server) to his computer. Mankoff et al teaches that the coupon can be redeemed at a retailer by synchronizing (connecting) the computer to the retailer computer and transferring the coupon to the retailer. Mankoff et al teaches delivery of electronic coupons to user devices such as PDA's, smart watches Internet appliances and other devices [col 3 lines 35-39]. Mankoff et al does not teach delivery to wireless phones. Sim (KR2000030358A) teaches delivery of electronic coupons to wireless phone users [pg 3] and it would have been obvious to one of ordinary skill at the time of the invention to have delivered the coupons of Mankoff et al

to user's phones as an alternative portable coupon device. Sim (KR2000030358A) teaches that a database is provided on coupon server 6 which stores users' phone numbers so that coupons can be delivered to a particular identified user phone. It would have been obvious to one of ordinary skill at the time of the invention for the user to have inputted/provided his wireless device identifying phone number (or other wireless identifier) to the banner advertising system so that his phone can be correctly identified in the database responsible for delivering the requested. Sim (KR2000030358A) teaches the ability to display the coupons [coupons have text and/or pictures - page 4: lines 18-22; phones have a display screen – FIG 1] and the concept to present the coupons to store employees for redemption [4:32-35]. The coupons of Mankoff et al and Sim (KR2000030358A) are both taken to be a purchasing incentives.

Regarding claims 3, 11, Official Notice is taken that display capabilities of cell phones vary from model to model and that some provide a text-only display while others enable monochrome images and others enable color images. It would have been obvious to one of ordinary skill at the time of the invention to have displayed a subset of coupon data (text and/or black and white images) on phones with less capable displays.

Regarding claims 4, 5 as best understood given the uncertain supported claim scope (as above), the art rejection as provided above is taken to read on the claim scope when considering the disclosed invention provided by the specification. In the event that applicant is capable of supporting secondary user input of information, Mankoff et al teaches a user cookie, user identifier and user authentication [5:35-46] which provides another input of user information. Further, Official Notice is taken that

cell phones are known to be able to browse web sites and it would have been obvious to one of ordinary skill at the time of the invention to have signed in to the service with a cell phone in order to view ads and request coupons be downloaded to any of several user-identified cell phone devices. Further, inasmuch as pertinent, Mankoff et al teaches that the site that provides the coupon-associated advertising may be a different server than the one which ultimately delivers the coupon to the identified user [col 2 lines 7-20, col 3 lines 50 to col 4 line 12, FIG 4].

Regarding claim 6 as best understood, Mankoff et al teaches that it is well known to receive electronic coupons and print them [col 1 lines 28-35].

**8. Claims 2, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view of Sim (KR2000030358A) and Golden et al (US57616448).**

Regarding claims 2, 10, Mankoff et al does not teach limiting the number of coupons to be downloaded to the user device. Golden et al also teaches downloading electronic coupons to a user computer. Golden et al provides a feature whereby the user may download only a certain number of coupons [col 4 lines 2-8]. It would have been obvious to one of ordinary skill at the time of the invention to have enabled such a provision of a predetermined maximum number of coupons that can be downloaded to the user's device. Such a feature would help prevent coupon fraud, for example.

***Response to Arguments***

Mankoff et al and Sim (KR2000030358A) as applied previously to claim 4 form the basis for this rejection, as each independent claim now includes features of previous claim 4. Applicant argues that Mankoff et al and Sim (KR2000030358A) do not teach or suggest claim 4. While the examiner has not found full support for the present claim 4, the rejection as presented herein to all independent claims is believed proper for the reasons provided.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc